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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,184	07/14/2006	Giuseppe Bordinon	6706/004	7294
22440 7590 09/17/2008 GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 10016-0601			EXAMINER DONDERO, WILLIAM E	
			ART UNIT 3654	PAPER NUMBER
			MAIL DATE 09/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,184	Applicant(s) BORDIGNON ET AL.	
	Examiner WILLIAM E. DONDERO	Art Unit 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/29/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed September 29, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A copy of the Japanese reference, JP62275980A, was not provided.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mandrel rotating about a vertical or inclined axis (Claims 21 and 37) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: references to the claims should not be in the Specification, therefore, the phrase, "as in claim 1" on page 5, lines 16-17 and "characteristics of claim 17" on page 5, line 20 should be deleted.

Appropriate correction is required.

Claim Objections

Claim 37 is objected to because of the following informalities: for definiteness and clarity, the word "element" should be changed to - -device- - in line 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32 and 34 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 32, the limitation, "substantially perpendicular to the mandrel" in line 2 renders the claim indefinite because it is unclear whether the limitation is modifying the flange, the inner plate or both. For the Office Action below it is presumed both the flange and inner plate are perpendicular to the mandrel.

Claim 34 recites the limitation "the protrusion" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-31 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bordignon et al. (US-6318660) in view of Kogos et al. (GB-1367513). Regarding Claims 21, 23 and 26, Bordignon et al. disclose a device 10 for coiling windable long, metal product comprising a mandrel 25 having a substantially circular traverse section and rotating around a horizontal axis, and at least a guide and containing device 39,40 able to be driven between a first working position (Figure 2) in which the guide and containing device cooperates with the mandrel, and a second inactive position (Figure 3) in which the guide and containing device is arranged distant from the mandrel (Figures 1-3). Bordignon et al. are silent about at least a clamping device associated with the mandrel, and able to clamp at least temporarily an initial segment of the metal product, wherein the clamping device comprises pincer means

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able to be selectively activated, which are arranged in correspondence with the outer surface of the mandrel in an inner position with respect to the outer surface of the mandrel; and an actuator device able to act on the respective arms of the pincer means, in order to perform the selective activation of the pincer means. However, Kogos et al. disclose a device for coiling windable long, metal product 30 comprising a mandrel 4 having a substantially circular traverse section and rotating around a horizontal axis, and at least a clamping device 14 associated with the mandrel, and able to clamp at least temporarily an initial segment of the metal product, wherein the clamping device comprises pincer means 15 able to be selectively activated, which are arranged in correspondence with the outer surface of the mandrel in an inner position with respect to the outer surface of the mandrel; and an actuator device 28,29 able to act on the respective arms of the pincer means, in order to perform the selective activation of the pincer means (Figures 1-4). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the pincer means to the device of Bordignon et al. to secure the initial end of the metal product as taught by Kogos et al. (Page 2, Lines 79-82). Regarding Claim 22, Bordignon et al. disclose the guide and containing device comprise means able to displace the metal product towards the clamping device (Figures 1-3 and Column 4, Lines 10-13). Regarding Claim 27, Bordignon et al. disclose an inner plate (behind 24) provided to define one of the lateral walls between which the metal product is wound (Figures 1-3). Regarding Claims 28, Bordignon et al. disclose the inner plate defines an annular channel (between the surface of 25 and the bottom edge of the inner plate) in proximity with the outer surface of the mandrel

(Figures 1-3). Regarding Claims 29-31, Bordignon et al. disclose the guide and containing device comprises a first flap 39 and a second flap 40 diametrically opposite the first flap constituting, in the first working position, a later cover to the annular channel (Figures 1-3).

Regarding Claim 24, Bordignon et al. in view of Kogos et al. is silent about the pincer means being arranged in an outer position with respect to the outer surface of the mandrel. However, one of ordinary skill in the art at the time of the invention would recognize it would have been an obvious design choice to move the pincer means to an outer position with respect to the outer surface of the mandrel to allow the pincer means to be easily accessible and repaired, if necessary.

With respect to claim 25, Bordignon et al. in view of Kogos et al. does not disclose specific values for number of pincer means. However, one of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been obvious through routine experimentation and optimization, for one of ordinary skill in the art to use as many pincers, such as four, as necessary to equally hold and secure the metal product to the mandrel.

Regarding Claim 37, Bordignon et al. disclose a method for coiling a long metal product, performed by means of a coiling device 10 which comprises a mandrel 25 having a substantially circular traverse section and rotating around a horizontal axis, and at least a guide and containing device 39,40 able to be driven between a first

working position (Figure 2) in which the guide and containing device cooperates with the mandrel, and a second inactive position (Figure 3) in which the guide and containing device is arranged distant from the mandrel, the method comprising a first step wherein a leading end of the metal product is inserted into a groove 41 of the guide and containing device arranged in the first working position, so as to guide the metal product along an outer surface of the mandrel; a third step wherein the guide and containing element is taken from the first working position to the second inactive position; and a fourth step wherein the metal product is wound from the remainder of its length (Figures 1-3; Column 4, Line 58 - Column 6, Line 2). Bordignon et al. are silent about a second step wherein the metal product is gripped and clamped at least temporarily on the mandrel by means of one or more pincers arranged in correspondence with the outer surface of the mandrel. However, Kogos et al. disclose a method for coiling a long metal product 30 comprising a step wherein the metal product is gripped and clamped at least temporarily on the mandrel by means of one or more pincers 15 arranged in correspondence with the outer surface of a mandrel 4 (Figures 1-4; Page 2, Line 105 – Page 3, Line 27). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the gripping and clamping step with the pincers of Kogos et al. to the method of Bordignon et al. to ensure the initial end of the metal product is gripped as taught by Kogos et al. (Page 2, Lines 79-82). Regarding Claim 38, Bordignon et al. disclose before the first step, the metal product is inserted into the groove by means of a distributor 45 of the metal product (Figures 1-3; Column 4, Line 58 - Column 6, Line 2). Regarding Claim 39, Bordignon et al. disclose wherein during

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the first step, the mandrel is in rotation around its own axis (Figures 1-3; Column 4, Line 58 - Column 6, Line 2). Regarding Claim 40, Bordignon et al. disclose during the first step the metal product is guided from the groove inside an annular channel (between the outer surface of 25 and the bottom of the inner plate behind 24) arranged on a inner plate (behind 24) of the mandrel (Figures 1-3; Column 4, Line 58 - Column 6, Line 2).

Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bordignon et al. (US-6318660) in view of Kogos et al. (GB-1367513) as applied to claims 21-31 and 37-40 above, and further in view of Moslener (US-3945585).

Regarding Claims 32-33, Bordignon et al. disclose wherein a flange 24 is applied on the inner plate substantially perpendicular to the mandrel. Bordignon et al. in view of Kogos et al. is silent about the flange being shaped so as to have an annular tooth substantially coaxial with the mandrel, the annular tooth defining an annular channel; and the tooth having a thickness substantially equal to the diameter of the metal product or a multiple thereof. However, Moslener discloses a device for coiling a windable, long, metal product comprising a tooth 6 substantially coaxial with the mandrel, the tooth defining a channel 10; and the tooth having a thickness substantially equal to the diameter of the metal product or a multiple thereof (Figure 1). It would have been obvious to one of ordinary skill in the art to add the tooth of Moslener in an annular form thereby forming an annular channel in the device of Bordignon et al. in view of Kogos et al. to more securely hold the metal product. Regarding Claim 36, Bordignon et al. discloses the flange is made of material of great hardness (as it is made of wear resistant materials) (Figures 1-3; and Column 4, Lines 23-26).

With respect to claim 34, Bordignon et al. in view of Kogos et al. and Moslener does not disclose specific values for the protrusion of the annular tooth. However, one of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been obvious through routine experimentation and optimization, for one of ordinary skill in the art to make the protrusion of the annular tooth between 1.5 and 2 times the diameter of the metal product to secure the first few layers rather than just the first layer.

Regarding Claim 35, Bordignon et al. in view of Kogos et al. and Moslener are silent about the flange being interchangeable according to the size of the metal product. However, one of ordinary skill in the art at the time of the invention would recognize the obvious design choice to make the flange interchangeable to easily replace them when they wear out.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Castellani (US-7246767) is cited for disclosing a device for coiling a windable, long, metal product with a flange with a tooth and channel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM E. DONDERO whose telephone number is (571)272-5590. The examiner can normally be reached on Monday through Friday 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. E. D./
Examiner, Art Unit 3654
/Peter M. Cuomo/
Supervisory Patent Examiner, Art Unit 3654